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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,869	09/08/1999	MARY SMITH	83317/00004	9219

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 02/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/391,869

Applicant(s)
Mary Smith

Examiner
Mark Henderson

Art Unit
3722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 28, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 32-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim 1 has been amended for further examination.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Michlin (5,141,252).

Michlin discloses in Fig. 1-3, a pocket insert capable of passing through a printer (Col. 3, lines 15-18) comprising a base sheet (16) with a thickness and a binding edge (folded area located at binding staple 12), a pocket sheet (17) having the same thickness as that of the base sheet (Col. 2, lines 40-46), an adhesive or securing means between the base sheet and the pocket sheet to form a pocket with an opening ^c facing the binding edge, and wherein the pocket insert has a maximum thickness equal to a combined thickness of the single thickness (from base sheet), the single sheet thickness (pocket sheet) and the adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 and 32-34, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dick (1,495,953) in view of Friedman (5,042,841).

Dick discloses in Fig. 1-3, a book (Fig. 3) having multiple pages (shown, but not indicated), a front and back covers (9) bound along the binding (spine which consist of rings), and a pocket insert (A) to hold multipage supplemental media materials (8) comprising a base sheet (1) of paper material having a binding edge (12), a planar first surface (1a), a planar second surface (1b); a pocket sheet (4) having a planar inner surface (4a), a planar outer surface (4b), a width smaller than the width of the base sheet, a perimeter (5) defined by an attached edge section (5a, 5b, 5c) and a free edge section (5d) on the inner surface (shown in Fig. 2), wherein at least a portion of the attached edge section is adhered to the first surface (1a) of the base sheet (1) along a plurality of seams (stitch seams) and the free edge section (5d) being unattached to the base sheet to form a pocket (C); an opposing first (11) and second (12) edges, and an opposing third (13) and fourth (14) edges.

However Dick does not disclose: wherein the base sheet and the pocket sheet are arranged such that the pocket opening faces and is parallel to the binding; a base sheet having a first edge, a first and second edges defining the width of the base sheet, and a third and fourth edges defining the length of the base sheet; a pocket sheet having a first edge attached to the base sheet, an opposing second edge wherein the first and second edges define the width of the pocket sheet,

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and an opposing third and fourth edges defining the length of the pocket sheet and being attached to the base sheet; and wherein the pocket sheet has a shorter width than the base sheet.

Friedman discloses in Fig. 1, a pocket insert (10) made of paper material comprising a base sheet (14) and a pocket sheet (12) arranged such that the pocket opening (22) is parallel to the binding (30), and having a base sheet (14) having a first edge (18) and a second edge (24) wherein the first and second edges define the width of the base sheet, and a third (16) and fourth (20) edges defining the length of the base sheet; and a pocket sheet having a first edge (18) attached to the base sheet, an opposing second edge (22) wherein the first and second edges define the width of the pocket sheet, and an opposing third (16) and fourth edges (20) defining the length of the pocket sheet and being attached to the base sheet (being attached through flaps (50); and wherein the pocket sheet has a shorter width than the base sheet.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dick's pocket insert to include a pocket sheet rearranged in which the pocket faces the binding edge as taught by Friedman for the purpose of providing a more secured pocket to hold items from slipping out.

In regards to **Claim 3, 4, 16-18, 25, 32, 33**, it would have been an obvious matter of design choice to construct the pocket sheet width in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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In regards to **Claim 5, 7, 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the base sheet and pocket sheet, and base sheet and second edge being separate sheet, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In regards to **Claims 10, 14, 15, 24**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form as many pockets as desired on the insert, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 2, 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the pocket sheet along any desirable edges, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Arguments

4. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

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In response to applicant's argument that there is no disclosure in the Dick reference that the sheets are adhered together and that the reference does not disclose adhered sections, the examiner submits that Dick does disclose "adhered sheets and sections". Webster's Dictionary defines the term "adhere" as "to hold fast or stick by or as if by gluing, suction, grasping or fusing." The examiner has interpreted "stitching" as a form of grasping in its broadest reasonable sense. Therefore, the term "adhere" can be interpreted to incorporate various forms of attaching.

In response to applicant's argument that the cited references do not disclose having a planar inner surface and an attached edge section on the inner surface which is attached to the first surface of the base sheet, the examiner submits that the Dick reference does disclose this in Fig. 2, in which a minute edge section on the inner surface of the pocket sheet (4) does attach to the first surface of the base sheet (1). Therefore, claim 32 is not in condition for allowance.

In response to applicant's argument that the Michlin reference does not disclose a binding edge, the examiner submits that there is indeed a binding edge located at folded area near binding staple (12a). The applicant must note that a binding edge does not necessarily mean that the edge has to be located at the end of a sheet.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

February 26, 2002



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